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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,695	05/05/2006	Sandro Gerd Thronicke	SCH002-US	4937

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EXAMINER	
WENDELL, MARK R	

ART UNIT	PAPER NUMBER
3635	

MAIL DATE	DELIVERY MODE
12/01/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/595,695	THRONICKE ET AL.	
	Examiner	Art Unit	
	MARK R. WENDELL	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 May 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20070515*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/595697. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose and claim roughly the same structure. The only difference between the applications is the addition of a drainage layer identical (according to claim 2 of the instant application) to the anchoring layer to the bottom of the sealing apparatus. It would be obvious to duplicate the anchoring structure within the apparatus to provide further reinforcement to the apparatus as a whole.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 9-10, 12-13, 16-19 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutjahr (US 6151854) in view of Siplast GMBH (EP0386324). Regarding claims 1, 2, 13 and 17 Gutjahr illustrates in Figure 2 a multilayer decoupling, sealing and drainage system (Figure 2) in particular for laying ceramic paving (24, and see column 1 for ceramic limitation) by using a thin-bed method (See column 1, line 37), said system comprising a layered construction containing, from the base upwards,

- A drainage layer (10) comprising drainage areas (14) and a sealing layer (20);
- A liquid-permeable and non-woven layer (laminated adhesive, 31);
- An anchoring layer (30) that is configured from a lattice-type structural element (See Figure 5 for lattice-type configuration) and used to hold a filler material (26) that is to be incorporated into the upper face of the sealing and drainage system (See Figure 2), which is plastic during

processing and subsequently cures (the examiner notes that the tile adhesive, or mortar, is flowable or plastic and then hardens when it cures). However, the reference does not distinctly disclose the drainage layer being made of a lattice-type structural element or a reinforcing layer on the top of the apparatus. Siplast illustrates in Figures 1 and 2 a multilayer decoupling and sealing system with a reinforcing layer (3a), characterized in that adjacent the reinforcing layer (3a) that is composed of either a non-woven of woven fabric or a film, there is an anchoring layer (3b) formed from a lattice-type structural element for incorporating filler material (6) which is plastic when being applied and subsequently hardens within the anchoring layer. It would have been obvious to modify the anchoring and reinforcing layers of Gutjahr with those of Siplast to sealingly cover cracks that may arise in the base (see Siplast abstract). The examiner notes that in column 5 of Gutjahr, the prior art states that modifications can be made within structure as long as the scope of the invention remains unchanged, therefore providing motivation to replace the reinforcing and anchorage structure with a different sized and shaped structure that provides the same function.

It would have also been obvious to one having ordinary skill in the art at the time of invention to replace the drainage structure of Gutjahr with the upper ply grid of Siplast in order to more drainage pathways for water to travel. The examiner notes that in column 5 of Gutjahr, the prior art states that modifications to the size and shape of the drainage structure are within the scope of the invention, therefore providing motivation to replace it with a different sized and shaped drainage structure. It is well known in the

art to use lattice type drainage structure for additional pathway and to focus water flow to a certain area.

Regarding claim 3, Siplast illustrates in Figure 1 the lattice-type structural element (3b) formed from individual rods that are disposed to one another in the manner of a lattice and fixed to one another at the points of intersection (see the overlap in Figure 1).

Regarding claim 4, Siplast does not distinctly teach the rods being of rectangular cross-section; rather they teach the rods having a circular cross-section. It would have been obvious matter of design choice to modify the rods to have a rectangular cross section since the applicant has not disclosed that having the rods be rectangular in cross section solves any stated problem or yield any unpredictable results and it appears that the system would perform equally as well with the rods having a circular cross-section.

Regarding claim 5, Siplast illustrates in Figure 1 the intersecting rods of the structural elements are arranged so that a first layer consists of identically oriented rods (all facing left to right) beneath a second layer of individual rods disposed at an angle (90 degrees) to the first layer and or oriented in the same direction as one another (all facing vertically).

Regarding claim 6, Siplast illustrates in Figure 1 the lattice structure formed by the rods of 3b are in the form of a square, which by definition is also a rectangle and rhombus.

Regarding claims 9 and 10, Siplast illustrates free, channel-like formed between the first and second layer (vertical and horizontal layers) of individual rods (3b).

Regarding claim 12, the invention of Gutjahr in view of Siplast has a reinforcing layer (3a of Siplast) cemented (via filler material 6 of Siplast) onto the anchoring layer (3b).

Regarding claim 13, Siplast describes in the abstract that the reinforcing layer (3a) being in the form of a lattice-type textile incorporated into the top of the sealing system. The examiner notes that the claim language "to provide for secure anchoring with the filler material" is functional language and is not given patentable weight (In re Fuller, 1929 C.D. 172; 388 O.G. 279). However, Gutjarh in view of Siplast inherent performs this function.

Regarding claim 16, Siplast illustrates in Figure 1 the sealing system being laid rigidly on the substratum (2). The examiner notes that the sealing system (3a) is laid on the substratum (2) and adhered thereto via an adhesive (1).

Regarding claim 18, Gutjahr illustrates in Figure 2 the sealing layer being a continuous layer and sealing multiple sections (underneath separate tiles).

Regarding claims 19 and 29, Gutjahr teaches in column 4 the sealing layer being slurry. The references do not distinctly disclose exactly what the slurry constitutes; however it

is well known to use bitumen for adhesion and it would have been obvious to one having ordinary skill in the art at the time of invention to use bitumen as an adhesive, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (In re Leshin, 125 USPQ 416).

Regarding claim 25, Gutjahr teaches in claim 17 of the prior art the liquid permeable non-woven layer (the textile mesh) exhibiting low resistance to the passage of liquid.

Regarding claim 26, Gutjahr illustrates in Figure 2 the liquid permeable layer (30) not allowing filler material to filter into the drainage layer (See the square openings in the drainage layer of Figure 2).

Regarding claim 27, Gutjahr teaches that the filler material (26) is mortar which inherently hardens and provides stiffening and reinforcing functions.

Regarding claim 28, Gutjahr illustrates in Figure 2 a sealing layer (20) and concrete (22) underneath the drainage layer. Both layers would inherently have noise attenuation properties.

Claims 7 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Gutjahr (US 6151854) in view of Siplast GMBH (EP0386324) as applied to claim 1 above, and

further in view of Barth et al. (US 6171015). It is described above what is disclosed by Gutjahr in view of Siplast; however regarding claims 6 and 10 the references do not distinctly disclose the individual rods being welded to one another or the reinforcing layer being welded to the anchoring layer. However, the references do show the layers being attached to one another and Barth teaches in column 3, lines 61- 67, "as far as the joint between adjacent elements of the supporting structure is concerned, provision can also be eventually made here so that the elements are positively connected to one another by clamp-shaped parts, by adhesive bonding or by welding." Therefore it would be obvious to one of ordinary skill in the art to substitute adhesive bonding for a weld and to weld adjacent layers together for stability purposes for the entire structure.

Claims 8 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutjahr (US 6151854) in view of Siplast GMBH (EP0386324) as applied to claim 1 above, and further in view of Nortene Technologies (FR 2774715). It is described above what is disclosed by Gutjahr in view of Siplast; however regarding claim 8 the references do not specifically disclose the individual rods having an undercut section. Nortene illustrates in Figure 1 the intersection of the rods having an undercut section. It would have been obvious to one having ordinary skill in the art at the time of invention to have the intersection of the rods have undercut sections for a more secure connection between the adjacent rods.

Regarding claim 20, Nortene discloses in claim 4 the sealing layer being formed from a polyethylene.

Regarding claim 21, Nortene teaches throughout the specification on Page 2 the sealing layer extending beyond the other layers.

Regarding claims 22 and 23, Nortene discloses in claim 4 the thickness of the anchoring layer being roughly between 2 and 6 mm, and therefore the drainage system being between 2 and 6 mm as per the modification described in the rejection to claim 1. The examiner notes that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (In re Aller, 105 USPQ 233).

Regarding claim 24, Nortene discloses in claims 4-8 various thicknesses of the layers within the system adding to roughly between 2 and 8 mm. The examiner notes that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (In re Aller, 105 USPQ 233).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gutjahr (US 6151854) in view of Siplast GMBH (EP0386324) as applied to claim 1 above, and further in view of Nakazawa (US 5238721)). It is described above what is disclosed by

Gutjahr in view of Siplast; however regarding claim 15, neither reference distinctly discloses the reinforcement layer being a floating layer on the substratum. Nakazawa teaches throughout the specification the reinforcement layer (5) floating on the substratum in an elastic nature. It would have been obvious to one having ordinary skill in the art at the time of invention to have the reinforcement layer be floating in nature to save costs by not using an expensive adhesive. Also, the examiner notes that there seems to be a lack of criticality in regards to the reinforcing layer being rigidly connected or floating because it is claimed in claim 16 of the instant application that the reinforcement layer can be rigidly attached as well.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK R. WENDELL whose telephone number is (571)270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

/M. R. W./
Examiner, Art Unit 3635
October 30, 2008